

REMARKS

Reconsideration of the above-identified application in view of the foregoing amendments and following remarks is respectfully requested.

A. Status of the Claims and Explanation of Amendments

Claims 1-3 and 5-13 and 15-20 are pending. By this paper, several amendments are made. Claim 14 has been cancelled without prejudice or disclaimer, and its features incorporated into independent claims 1 and 20. Claim 5 has been amended into independent form. Entry of these amendments is requested as simplifying matters for appeal.

Also, several formal amendments were made. In claim 1, Applicant previously changed the word "arrangements" to "protuberances" at the behest of the examiner. Upon reviewing the claims in responding to the present action, it was discovered that once instance of the word "arrangement" had not been changed in claim 1. Accordingly, that change is now made.

In addition, the office action (at page 8) opined that the language "able to divert" was not a positive limitation. Without commenting on that opinion, Applicant has now amended claims 1, 6, 9 and 20 to recite "diverting" rather than "able to divert." This is believed to further reduce issues for appeal. Also, pronouns, such as "this" and "it's", have been deleted and replaced with the element(s) to which they were referring. Also the antecedent basis for periphery in claim 10 was corrected. Entry of these amendments is requested pursuant to 37 C.F.R. § 1.116.

As Claims 1-3, 9-14, 19 and 20 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,795,171 to Lindae et al. ("Lindae"). Claims 1-3, 9-13 and 19 were rejected under 35 U.S.C. § 102(e) as allegedly be anticipated by U.S. Patent

Appl. No. 10/603,288
Paper dated July 6, 2005
Reply to office action dated April 20, 2005

No. 6,416,210 to Uchida ("Uchida"). Claims 5-8 and 15-18 were rejected under 35 U.S.C.

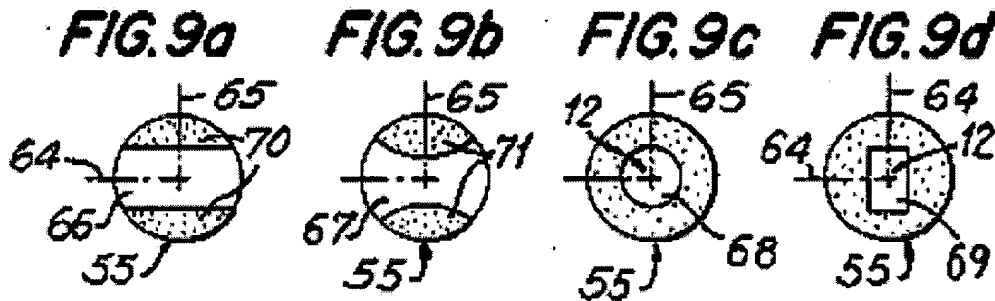
§ 103(a) as allegedly being unpatentable over either Lindae or Uchida.

B. Claims 1-3, 6-13 and 17-21 are Patentably Distinct from the Cited References

The rejections of claims 1-3, 6-13 and 17-19 are respectfully traversed. As explained more fully below, the requirements for such rejections are not met. In particular, Lindae and Uchida fail to teach, disclose or suggest an exit lens with "protuberances being produced solely on the side parts of the exit surface of the exit lens" as recited in Applicant's claim 1.

As to Uchida, the office action had not alleged that this reference anticipated or rendered obvious previously pending claim 14 ("wherein the protuberances are produced solely on these side parts") or claim 20 ("the modified surface regions being produced on at least one of the side parts of the exit surface of the lens"). Thus, the office action conceded that Uchida does not teach, disclose or suggest a headlamp with an exit lens having protuberances solely on side parts of the exit surface as recited in pending claim 1.

With regard to Lindae, the office action relied on Figures 9A to 9D, which show different modifications of objective 55 of Lindae's Figure 6. The office action suggests that these Figures (reproduced below) show protuberances on side parts of the exit surface, but not having protuberances on a central part:



In each of these figures, a smooth partial surface (66 through 69) is shown which does *not* disperse the passing light beam. [Lindae, Col. 4, lns. 47-50]. Although not expressly stated, microelements (58), which the office action argues correspondence to our claimed protuberances, are provided outside of these smooth partial surfaces on the objective 55. Vertical plane (65) is shown running through the central portions (66 to 69) as well as the surface portions having microelements (58). The office action appears to believe that these smooth partial surfaces correspond to the “central part” of Applicant’s claim 1 and 20.

As best understood, the office action suggests that central portions (68 and 69) of Figures 9c and 9d would correspond to Applicant’s claimed “central part,” and the partially shaded remainder of the objective (55) could then be divided along the vertical central plane (65) into “first and second part parts” as in Applicant’s pending claims.

However, this suggestion does not comport with the language of the claims. In particular, claim 1 recites, *inter alia*, that the central part “encompasses a region of the exit surface intersected by a vertical plane defined by an optical axis of the projection device.” As shown in the figures 9a-9d reproduced above, Lindae’s central portions (66, 68, 68 and 69) do not encompass the region intersected by such a vertical plane. To the contrary, Lindae’s figures

show vertical plane (65) is shown running through the central portions (66 to 69) as well as the surface portions having microelements (58).

Accordingly, as Applicant cannot find in Lindae or Uchida an exit lens with “protuberances being produced solely on the side parts of the exit surface of the exit lens” as in Applicant’s claim 1, at least independent claims 1 and 20, and their dependent claims 2-3, 6-13, 17-19, and 21 are respectfully asserted to be in condition for allowance.

C. Claims 5 and 15-16 are Patentably Distinct from the Cited References

The rejections of claims 5 and 15-16 also are respectfully traversed since the office action has failed to present sufficient evidence to support a *prima facie* case of obviousness. The office action has conceded the novelty of these claims, because Lindae and Uchida fail to teach, disclose or suggest protuberances with “a thickness of between 0.2 millimeters and 3 millimeters” as recited in Applicant’s claim 5. Nonetheless, the office action has asserted that the claimed features allegedly are obvious over Lindae or Uchida. In that regard, the present office action states:

“It would have been obvious to one having ordinary skill in the art at the time the invention was made to specify thickness of a protuberance, since it has been held that where the general conditions of a claim are disclosed in the prior art, ***discovering the optimum or workable ranges involves only routine skill in the art.*** *In re Aller*, 105 USPQ 233.” (4/20/05 Office Action at p. 6) (emphasis added).

The office action is correct that the U.S. Court of Customs and Patent Appeals (CCPA) established the rule that the discovery of an optimum value of a variable in a known process is ***normally*** obvious. See *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). However, as with many rules, there are exceptions to the CCPA’s rule. One exception is the case

where a parameter being optimized was not recognized to be a “result-effective variable.” See, e.g., *In re Yates*, 663 F.2d 1054, 1057, 211 USPQ 1149, 1151 (CCPA 1981);

Likewise, the Manual of Patent Examination Procedure (MPEP) § 2144.05 (at 2100-143) permits such an “optimization” rationale only when the references themselves recognize that the variable (here thickness) is a result effective variable. See, e.g., *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) (cited at MPEP § 2144.05, at 2100-143). In *Antonie*, the claimed wastewater treatment device recited a tank volume to contractor area of 0.12 gal./ft². That claimed device was held to be patentable over the prior art, because the prior art did not recognize that treatment capacity is a function of the tank volume to contractor ratio. That being the case, a person of ordinary skill in the art would not understand the need or benefit of optimizing that claimed parameter. In other words, the burden remains with the office action to show that variable in question is “known to be result effective.” *In re Antonie*, 559 F.2d at 621, 195 USPQ at 9.

Here, our review of Lindae and Uchida finds no such disclosure or understanding that would motivate a person of ordinary skill in the art to optimize protuberance thickness. Lindae’s microelements (58) appear to be superficial pits or imperfections that are introduced into the lens soften the sharp dark/light line. [Lindae, 4/17-27]. Thickness of the microelements is not discussed in Lindae. Likewise, Uchida discloses that his lens elements (18s) can have any “cross-sectional shape” and “vertical width.” [Uchida, 1/64-67]. Neither Lindae nor Uchida recognizes thickness to be of any importance. Thus, the determination of thickness cannot be an obvious expedient because the art fails to appreciate that thickness is a result effective variable, and the office action’s optimization rationale is inapplicable.

Accordingly, as Applicant cannot find in Lindae or Uchida protuberances with “a thickness of between 0.2 millimeters and 3 millimeters” as in Applicant’s claim 5, at least

Appl. No. 10/603,288
Paper dated July 6, 2005
Reply to office action dated April 20, 2005

independent claim 5, and its dependent claims 15 and 16 are respectfully asserted to be in condition for allowance.

Applicant has chosen in the interest of expediting prosecution of this patent applicant to distinguish the cited documents from the pending claims as set forth above. These statements should not be regarded in any way as admissions that the cited documents are, in fact, prior art. Likewise, Applicant has chosen not to swear behind Uchida cited by the office action at this time. Applicant, however, reserves the right, as provided for pursuant to 37 C.F.R. § 1.131, to do so in the future as appropriate.

Finally, Applicant has not specifically addressed the rejections of the dependent claims. Applicant respectfully submits that the independent claims, from which they depend, are in condition for allowance as set forth above. Accordingly, the dependent claims also are in condition for allowance. Applicant, however, reserves the right to address such rejections of the dependent claims in the future as appropriate.

Appl. No. 10/603,288
Paper dated July 6, 2005
Reply to office action dated April 20, 2005

CONCLUSION


For the above-stated reasons, this application is respectfully asserted to be in condition for allowance. An early and favorable examination on the merits is requested. In the event that a telephone conference would facilitate the examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY ADDITIONAL FEES WHICH MAY BE REQUIRED FOR THE TIMELY CONSIDERATION OF THIS AMENDMENT UNDER 37 C.F.R. §§ 1.16 AND 1.17, OR CREDIT ANY OVERPAYMENT TO DEPOSIT ACCOUNT NO. 13-4500, ORDER NO. 1948-4808.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: July 6, 2005

By: _____


Matthew K. Blackburn
Registration No. 47,428

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.
3 World Financial Center
New York, NY 10281-2101
(212) 415-8700 Telephone
(212) 415-8701 Facsimile